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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,705	10/23/2003	Tom H. Dao	9254195/THD/D125	9789

7590

10/03/2005

Tom H. Dao
100 Retreat
Irvine, CA 92603

EXAMINER

DAVIS, CASSANDRA HOPE

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/692,705	DAO, TOM H.	
	Examiner	Art Unit	
	Cassandra Davis	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 27-29 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 13, 2005 and July 13, 2005.

Specification

2. The disclosure is objected to because of the following informalities: it appears as if the term "sdies" in paragraph 0023, line 3, should read "sides".

Appropriate correction is required.

3. The use of the trademark POST-IT® has been noted in this application. It should be capitalized wherever it appears and *be accompanied by the generic terminology*.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "14" seen in figures 1 and 2.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, the POST-IT® or note pad recited in claim 15, 19, and 22 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement

sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15, 19, 21, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of trademarks in the claim is indefinite because the formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. See MPEP 608.01(v).

The trademark POST-IT® should be replaced by its generic term.

In claim 22, the phrase "packaging" lacks antecedent basis.

In claim 30, line 10; it is unclear if the phrase "the plurality of lines" refers to the "plurality of lines" recited on lines 5 or 10.

In claim 30, line 12, it is unclear if the phrase "a pre-formatted field" refers to the pre-formatted field recited on line 7.

In claim 30, line 12, it is unclear if the phrase "said as least one printed word" refer to the "at least one printed word" recited on line 7.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark, U. S. Patent 1,277,696. Clark teaches a container record comprising a container 5 having a pad 11, wherein the portion of the pad below the line 16 correspond to the template and the portion 17 of the pad above the line 16 correspond to the label. Clark teaches the container may be a box, bottle, carton, or other convenient receptacle. See page 1,

lines 49-52. The label portion 17 has preprinted data 18 and the template has a plurality of lines 20-23 and pre-printed indicia such a "patient".

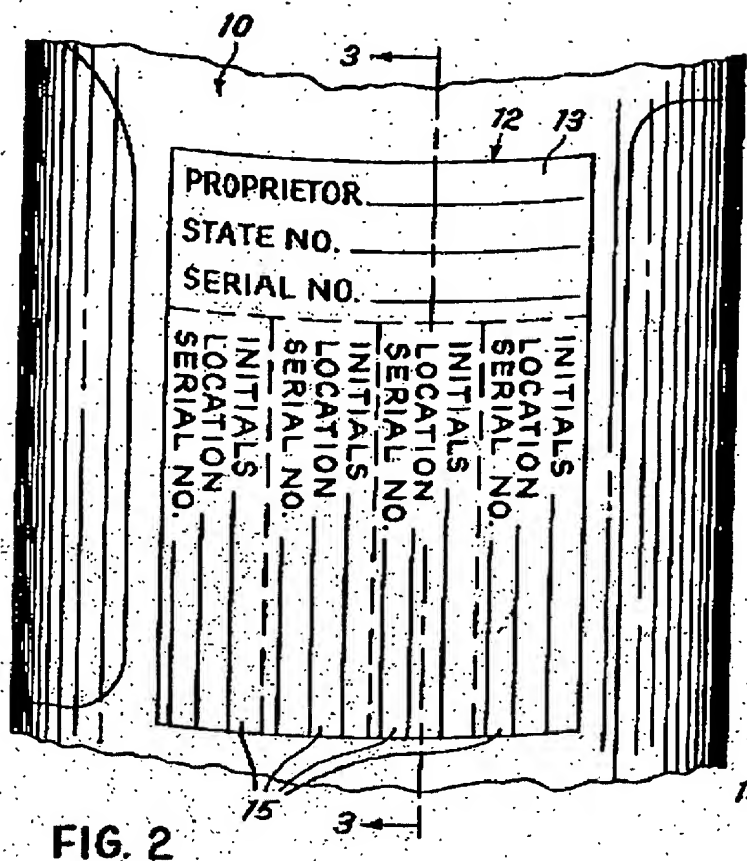
10. With respect to claim 3, the label portion 17 is integral with the template portion. See figure 1.

11. With respect to claims 4-6 and 9, Clark teaches the pad may be attached to the container using an adhesive strip 7 or may be directly attached to the container. See page 1, line 55-73.

12. Claims 1-4, 8-9, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Shea, U. S. Patent 3,484,976. Shea teaches a container 10 comprising a label 13 and plurality of templates 15 positioned between the ends of the label. See figure 1.

13. With respect to claim 2, the template has first column in portion 15. See figure 2.

14. With respect to claim 3, the template is separated from the label 13 by perforated line (not labeled).



15. With respect to claim 4, the label/template 12 is adhesively attached to the bottle.

16. With respect to claim 8, Shea teaches parallel lines on template portion 15 for writing information thereon, wherein the template and the label portion are adhesive attached to the bottle and is therefor a part of the bottle.

17. With respect to claim 30, one of the template 15 correspond to the first writing medium and a second template portion 15 correspond to a second writing medium.

18. Claims 1-4, 7-11, 13, 14, 16, 17, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Greco, U. S. Patent 3,517,450.

19. With respect to claims 1 and 30, Greco teaches a container 25 having a closed top end and an open bottom end. The container also has an adhesive recording member 10 adhesive attached thereto. The recording member has a label portion 11 and a template portion, wherein the template portion has portion 12, lines 13-19 for writing in information.

20. With respect to claim 2, the lines 17 and 18 are presented in columns.

21. With respect to claim 3, the label portion and the template portion are integral.

22. With respect to claim 4, the recording member is adhesive attached to the bottle.

23. With respect to claim 7, Greco teaches a field 12 indicating the volume of the container.

24. With respect to claims 8 and 9, the template comprising a plurality of lines 17, 18, and 19 for inserting information.

25. With respect to claims 10-11, Greco teaches providing a template (recording label 10) having a line 16 at the top of the label for recording the start time the contents of the bottle as administered and a line 19 at the bottom of the label for recording the stop time.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 7 and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark.

28. With respect to claim 18, Clark teaches the container 5 can be a box, bottle, carton, or other convenient receptacle. See page 1, lines 49-51.

Since placing a bottle within a box for merchandising is old and well known in the art, it would have been obvious to one having ordinary skill in the art at the time this invention was made to provide a box for receipt of the

medicine bottle taught by Clark to provide a means to store and display the bottle for sales.

29. With respect to claim 19, Clark teaches a note pad 11.

30. With respect to claim 20, the label portion 17 is integral with the template portion. See figure 1.

31. With respect to claims 21-23, Clark teaches the pad may be attached to the container using an adhesive strip 7 or may be directly attached to the container. See page 1, line 55-73.

Allowable Subject Matter

32. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following U. S. Patents are cited to show recordable labels attached to a container such as bottle: 5,752,723; 4,128,954; 2003/0122370; 3,437,243; and 6,135,507.

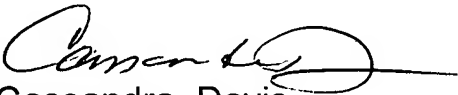
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone

number is 571-272-6642. The examiner can normally be reached on
Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Lesley Morris can be reached on 571-272-6651.

The fax phone number for the organization where this application or
proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained
from the Patent Application Information Retrieval (PAIR) system. Status
information for published applications may be obtained from either Private
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system, see <http://pair-direct.uspto.gov>. Should you have questions on
access to the Private PAIR system, contact the Electronic Business Center
(EBC) at 866-217-9197 (toll-free).


Cassandra Davis
Primary Examiner
Art Unit 3611

CD
September 26, 2005